

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC., APPLE INC., AND
MOTOROLA MOBILITY LLC.,

Petitioners,

v.

UNILOC 2017 LLC,

Patent Owner.

IPR2020-00701

PATENT 6,836,654

**JOINT MOTION TO TERMINATE AS TO PETITIONER SAMSUNG
PURSUANT TO 35 U.S.C. § 317**

Petitioner Samsung Electronics America, Inc. (“Samsung”) and Patent Owner Uniloc 2017 LLC (“Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Samsung and Patent Owner jointly move to terminate the present *inter partes* review proceeding with respect to Samsung.

I. STATEMENT OF FACTS

Samsung and Patent Owner have reached an agreement to resolve the Parties’ disputes. The settlement agreement settles (i) this proceeding, and (ii) the related district court litigation styled *Uniloc 2017 LLC v. Samsung Electronics America, Inc.* et al 2-18-cv-00508 (EDTX). A stipulation of voluntary dismissal with prejudice was filed in the district court litigation on May 27, 2020. The Court dismissed the case on May 28, 2020.

Pursuant to 37 C.F.R. §42.74(b), the Parties’ settlement agreement is in writing, and a true and correct copy is being filed as Exhibit 2001. The settlement agreement is being filed electronically with access to “Board Only.” A “*Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate seeking to treat the settlement agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37

C.F.R. § 42.74(c). The Board provided authorization to file this motion in an email dated June 3, 2020.

II. ARGUMENT

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding as to Samsung, as the Parties jointly request, for the following reasons.

First, Samsung and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, Samsung and Patent Owner have reached a settlement as to all the disputes in this proceeding and as to the patent at issue. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 2001. Samsung and

Patent Owner request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The Parties certify that Confidential Ex. 2001 is a true copy of the settlement agreement (with no redactions); there are no collateral agreements referred to in the settlement agreement; and there are no other agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.;

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Samsung and Patent Owner respectfully request termination of this *inter partes* review with respect to Samsung.

Respectfully submitted,

/Naveen Modi/

Lead Counsel
Naveen Modi
(Reg. No. 46,224)

Back-up Counsels
Joseph E. Palys
(Reg. No. 46,508)
Phillip W. Citroën
(Reg. No. 66,541)

Attorneys for Petitioner

Date: June 10, 2020

Respectfully submitted,

/Ryan Loveless /

Lead Counsel
Ryan Loveless
Reg. No. 51,970
ETHERIDGE LAW GROUP
2600 E. Southlake Blvd., Ste. 120-324
Southlake, Texas 76092
Telephone: (972) 292-8303

Back-up Counsels
Brett A. Mangrum
Reg. No. 64,783

Attorneys for Patent Owner

Date: June 10, 2020

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has been served in its entirety via email, pursuant to the parties' agreement, to the following attorneys of record listed below:

Lead Counsel	Tiffany C. Miller, Reg. No. 52,032	Apple-Uniloc19- DLA@us.dlapiper.com
Back Up Counsel (for Apple and Motorola)	James M. Heintz, Reg. No. 41,828	Apple-Uniloc19- DLA@us.dlapiper.com
Back Up Counsel (for Samsung)	Naveen Modi, Reg. No. 46,224 Joseph E. Palys, Reg. No. 46,508 Phillip W. Citroën, Reg. No. 66,541	PH-Samsung-Uniloc- IPR@paulhastings.com

Dated: June 10, 2020

By: / Ryan Loveless /
Ryan Loveless
Reg. No. 51,970
Brett A. Mangrum
Reg. No. 64,783
Attorneys for Patent Owner